

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Nicolas Popp

Application No.: 10/590,415

Filed: Feb 23, 2005

For:

TOKEN AUTHENTICATION SYSTEM
AND METHOD

Confirmation No.: 7016

Examiner: James Nigh

Art Unit: 3685

Customer No.: 12334

PETITION UNDER 37 C.F.R. §1.181 TO
DESIGNATE A NEW GROUND OF
REJECTION IN THE EXAMINER'S
ANSWER

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

This is a petition to request that one or more grounds of rejection set forth in the Examiner's Answer dated February 15, 2011 be designated as new grounds of rejection.

In support of this request, Applicants submit the following:

1. The Examiner's Answer relies upon a new reference and a new definition of the term "device." (p. 16.) This reference has not previously been made of record. This alone is sufficient to require designation of a new ground of rejection. (*See* M.P.E.P. §1207.03, Part III ("A new prior art reference applied or cited for the first time in an examiner's answer generally will constitute a new ground of rejection.")).
2. Further, the new reference is relied upon to present an entirely new position that has not previously been asserted with respect to the pending claims. Specifically, the Examiner relies upon the newly-presented definition to argue that the term "device" may refer to "an

abstraction,” such as “something in a literary work designed to achieve a particular artistic effect.” (p. 16.) Although the Examiner has previously argued that various claim features do not necessarily constitute or require a physical device, the Examiner has not previously made the argument that the term “device” *by itself* may refer to nothing more than an abstraction such as a literary effect. Applicants have not had a sufficient opportunity to address this new position by way of argument or amendment. For at least this additional reason, the Examiner’s Answer should be corrected to indicate a new ground of rejection has been presented.

3. The Final Office Action cites to Matyas, and the Examiner argues that Matyas discloses “workstations” that are properly interpreted as the recited “token” because a workstation is a physical device. (Final Office Action, p. 5.) This position is repeated in the Examiner’s Answer, in a “Response to Arguments” section (p. 3-7.) However, at page 17 the Examiner’s Answer presents the new argument that the “token” recited in the claims is disclosed as a “virtual device” operating *within* Matyas’ workstations, which were previously alleged to disclose the tokens themselves:

The token in this instance can be viewed as the "suitable combination of hardware and/or software" (4:29-30) within the workstation disclosed by Matyas. As such the "token" would constitute a virtual device operating within the physical workstation performing the functions of the token as recited. A secret is uniquely assigned to the token (5:1-16) which is shared between the token and the authentication server (which in this case would comprise the other user. The virtual token of user A would be viewed as having its secret shared with user B which in effect becomes the authentication server for user A; similarly the virtual token of user B would be viewed as having its secret shared with user A which becomes the authentication server for user B using Matyas' example, 4:37-46,6:2-7).

(Emphasis added.) This analysis of Matyas as containing a “virtual device” within the workstation has not been presented before, nor has the Examiner previously alleged that users in Matyas’ system disclose “authentication servers” that authenticate other users’ virtual tokens. In presenting this interpretation to support the rejection of claim 1, the Examiner has provided a new ground of rejection. (*See In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 51 (Fed. Cir. 2005) (new calculation applied to a reference not “simply an additional explanation,” but constitutes a new ground of rejection).) For at least this additional reason, the Examiner’s Answer should be corrected to indicate that a new ground of rejection has been relied upon.

For the reasons stated above, Applicants submit that the Examiner's Answer contains new grounds of rejection. For each new ground of rejection described above, Applicants respectfully request that the new ground be identified as such, and that the Office mail a corrected Examiner's Answer accordingly.

Respectfully Submitted,

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DATE: April 7, 2011
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